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DEC 28 2006

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REMARKS

Applicants have amended claims 8, 34 and 36, and have cancelled claims 30-33 and 37-50. Care has been taken to avoid adding new matter. Claims 1-29 and 34-36 are presently pending in the application.

The Office Action objected to claims 34-36 under 37 C.F.R. 1.75(c) as being of improper dependent form for purportedly failing to limit the subject matter of a previous claim, and further alleged that the mentioned claims were directed to method steps while depending upon apparatus claims. In response, Applicants submit that claims 34-36, as amended, limit the subject matter of the previous claims from which they depend and further are directed to method steps as are the previous claims from which they depend. Applicants thus request reconsideration and withdrawal of the current objection.

The Office Action rejected claims 1-29 and 34-36 under 35 U.S.C. 112, second paragraph, as being indefinite for allegedly failing to point out what is included or excluded by the claim language. In particular, the Examiner alleged that the term "substantially" rendered the claims indefinite in that the term purportedly fails to point out the metes and bounds of certain aspects of the claims. In response, Applicants respectfully traverse this rejection. Even assuming, hypothetically, the Examiner's characterizations to be correct to an extent sufficient to introduce imprecision into the claims as a result of the "substantially" term, Applicants assert that this term is still permissible in the current context of the claims and that it does not violate the provisions of 35 U.S.C. 112, second paragraph.

Section 2173.05(b) of the Manual of Patent Examining Procedure (MPEP), for example, acknowledges that, as a general proposition, broadening modifiers are standard tools in claim drafting in order to avoid reliance on the doctrine of equivalents in infringement actions. This section of the MPEP states that imprecise claim language, including terms of degree, do not automatically render the claim indefinite under 35 U.S.C. 112, second paragraph and that

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acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed, in light of the specification. Section 2173.05(b) of the MPEP continues, stating that the term "substantially" is often permissibly used in claims in conjunction with another term to describe a particular characteristic of the claimed invention.

The same MPEP section provides as exemplary permissible uses the following: the limitation "to substantially increase the efficiency of the compound as a copper extractant" which was held to be definite in view of the general guidelines contained in the specification, and the limitation "which produces substantially equal E and H plane illumination patterns" which was held to be definite because one of ordinary skill in the art would know what was meant by "substantially equal." In the present application, Applicants submit that the Detailed Description and drawings of the current specification, as interpreted by one having skill in the art, provide sufficient guidance and standards for enabling a skilled artisan to determine the meaning of "substantially" in the claimed contexts; thus, the claimed instances of "substantially" are sufficiently definite in view of the general guidelines and embodiments contained in Applicants' patent application. In any event, one of ordinary skill in the art would nevertheless be reasonably apprised of the scope of the claimed invention, in further view of the prior art and the status of the art.

Regarding the rejection of claims 34-36, these claims, as mentioned above, are indeed, directed to method steps and thus are commensurate in application with the previous claims from which they depend.

Applicants thus request reconsideration and withdrawal of the current rejections of claims under 35 U.S.C. 112, second paragraph.

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Rejections Under 35 U.S.C. § 102

The Office Action rejected claims 1, 2, 4, 5, 14-17, 21 and 22 under 35 U.S.C. 102(b) as allegedly being anticipated by Arm et al. (WO 93/20859). Applicants respectfully traverse the rejection and submit that, since the October 28, 1993 publication date of Arm et al. is less than a year before Applicants' filing date of July 31, 2003, the Arm et al. reference is not prior art under 35 U.S.C. 102(b). Additionally, Applicants' have a priority date of September 9, 2002, which is even earlier than, i.e., over a year prior to, the October 28, 1993 publication date of Arm et al.

The Office Action rejected also rejected claims 1, 4, 7, 13-23, 25 and 29 under 35 U.S.C. 102(e) as allegedly being anticipated by Lahtinen et al. (US 2003/0059463). Applicants respectfully traverse this rejection, as well, for the following reasons.

It is well known that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." (Emphasis added; Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). Thus, for a rejection under 35 U.S.C. 102 to be proper, every limitation recited in a claim, which is rejected as being anticipated by a prior-art reference, must be clearly disclosed in that single prior-art reference. In the instant case, Applicants respectfully submit that the cited Lahtinen et al. reference does not disclose each and every element that is recited in the rejected claims, and, therefore, the cited Lahtinen et al. reference does not anticipate the claims under 35 U.S.C. § 102.

Applying the above standard, Lahtinen et al. does not disclose a method for attenuating adhesions between an implant and surrounding tissue following a surgical procedure in a patient, comprising a combination of steps including, among other things, "providing a non-porous, resorbable polymer base material; and applying the resorbable polymer base material in a form of a resorbable thin membrane around the implant to thereby cover substantially all exposed surfaces of the implant, wherein the resorbable thin membrane is substantially non-porous and comprises

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a layer of polymer base material selected from the group consisting essentially of: a lactide polymer; and a copolymer of two or more cyclic esters" (emphasis added), as recited in independent claim 1.

As noted on page 5 of the Office Action, the device of Lahtinen et al. comprises "a core and a nucleic acid present in a biologically compatible medium," which medium may comprise "poly-(L-lactic acid), ... poly(D,L-lactic acid)" In contrast, the composition of Applicants' layer of polymer base material as recited in claim 1 is selected from the group consisting essentially of a lactide polymer and a copolymer of two or more cyclic esters. Thus, claim 1, and the claims dependent therefrom, are not anticipated by Lahtinen et al. under 35 U.S.C. § 102.

Moreover, concerning the Arm et al. reference (which as set forth above is not 35 U.S.C. 102(b) prior art), as noted by the Examiner on page 3 of the Office Action and as stated in the first paragraph of the Detailed Description of Arm et al., the "compositions are in the form of biodegradable polyester films ..., one or more peptide growth factors, and a carrier" In contrast, the composition of Applicants' layer of polymer base material as recited in claim 1 is selected from the group consisting essentially of a lactide polymer and a copolymer of two or more cyclic esters. Thus, even if Arm et al. were to be established under a provision of 35 U.S.C. 102 other than 102(b) to constitute prior art, Applicants respectfully submit that claim 1, and the claims dependent therefrom, still would not have been anticipated by Arm et al.

Applicants respectfully request that the Examiner reconsider and withdraw the rejections of the claims based upon 35 U.S.C. § 102.

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Rejections Under 35 U.S.C. § 103

Claims 1, 4, 7-18, 21 and 22 stand rejected by the Office Action under 35 U.S.C. 103(a) as allegedly being unpatentable over Hossainy et al. (US 6541373). Applicants respectfully traverse this rejection.

Regarding this outstanding rejection, it is well established that a claim can be rejected on obviousness grounds only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior-art reference or combination of prior-art references. Thus, for a rejection under 35 U.S.C. 103(a) to be proper, every limitation recited in a claim, which is rejected as being obvious in view of a combination of prior-art references, must be disclosed or taught in that collection of prior-art references. In the instant case, Applicants respectfully submit that the cited references neither teach nor suggest each and every element that is recited in the rejected claims. More particularly, applying the above standard, Hossainy et al. neither teaches nor suggests a method for attenuating adhesions between an implant and surrounding tissue following a surgical procedure in a patient, comprising a combination of limitations, including, among other things, "providing a non-porous, resorbable polymer base material; and applying the resorbable polymer base material in a form of a resorbable thin membrane around the implant to thereby cover substantially all exposed surfaces of the implant, wherein the resorbable thin membrane is substantially non-porous and comprises a layer of polymer base material selected from the group consisting essentially of: a lactide polymer; and a copolymer of two or more cyclic esters" (emphasis added), as recited in independent claim 1.

Accordingly, as further set forth below, the outstanding rejections under 35 U.S.C. § 103(a) are improper and should be withdrawn.

The Office Action asserts that Hossainy et al. "teaches, a 'method of forming a therapeutic coating onto a surface of an implantable prosthesis.'" Applicants submit, however, that this quoted language contains nothing more than the subject matter already disclosed by Applicants in the

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Background of the Invention section of the presently pending patent application.

In fact, Applicants' Background of the Invention section states that "[o]ne approach to the problem of adhesion has been the use of bioresorbable barrier materials, in the form of ... coatings, ... films, and the like, that are placed between a healing post-surgical site and adjacent surrounding tissue." Clearly, Applicants' presently claimed invention is not directed to such a broad concept and, accordingly, it is requested that all limitations of the claims be considered and examined so that the claims are not construed by the Examiner to cover such general concepts as any and bioresorbable coatings on implants.

Moreover, Applicants' Background of the Invention section actually discusses one of the Hossainy et al. references, U.S. Patent No. 6,153,252, characterizing it as disclosing "[a]n exemplary method for coating a stent" to address "the problem of foreign body reactions ... by applying biocompatible polymeric coatings to ... stents."

Applicants respectfully submit that the prior art Hossainy et al. devices neither disclose nor suggest Applicants' claimed layer of polymer base material selected from the group consisting essentially of a lactide polymer and a copolymer of two or more cyclic esters. Indeed, while the disclosure of Hossainy et al., as noted on page 8 of the Office Action, may elucidate a polymeric material that may comprise poly-D,L-lactide, this material would appear to be limited to making-up no more than 30% of the composition. Such a composition, thus, does not amount to or even suggest, among other things, a layer of polymer base material selected from the group consisting essentially of a lactide polymer and a copolymer of two or more cyclic esters, as recited in claim 1.

Additionally, regarding rejections imposed by the Office Action under 35 U.S.C. §103, the Office Action rejected claims 1-6 and 21-29 under 35 U.S.C. 103(a) as allegedly being unpatentable over Ledergerber et al. (US 4955907) in view of Calhoun et al. (US 2002/0001609). Applicants respectfully traverse this rejection, as well, since, for example, the Calhoun et al.

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subject matter and the currently claimed invention were, at the time the claimed invention was made, owned by the same entity, MacroPore, Inc." Attached hereto as Exhibit A is an Assignment, which establishes ownership of the current application to MacroPore Biosurgery, Inc. Also, attached Exhibit B is a document showing a name change from MacroPore, Inc. to MacroPore Biosurgery, Inc., thus establishing that the two mentioned entities are the same. Accordingly, since the subject matter of the Calhoun et al. reference was owned by the assignee of the present application at the time the claimed invention was made, the current rejection is improper and should be withdrawn.

It is submitted that the presently pending dependent claims are allowable at least because of their dependencies upon independent, amended claim 1, and further because of the additional limitations recited in those dependent claims.

Accordingly, in view of the preceding, Applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. §103.

Applicants submit that the application is now in condition for allowance, and an early indication of same is requested. The Examiner is invited to contact the undersigned with any questions.

Respectfully submitted,



Kenton R. Mullins
Attorney for Applicants
Registration No. 36,331

December 28, 2006

Stout, Uxa, Buyan & Mullins, LLP
4 Venture, Suite 300
Irvine, CA 92618
Telephone: (949) 450-1750
Facsimile: (949) 450-1764

Exhibit A

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WHEN RECORDED, RETURN TO:

Kepton R. Mullins
STOUT, UXA, BUYAN & MULLINS, LLP
4 Venture, Suite 300
Irvine, CA 92618

ASSIGNMENT

WHEREAS, WE, CHRISTOPHER J. CALHOUN, RALPH E. HOLMES and G. BRYAN CORNWALL, all residing in California, have invented certain new and useful improvements in:

**APPARATUS AND METHOD FOR PREVENTING ADHESIONS
BETWEEN AN IMPLANT AND SURROUNDING TISSUES**

for which the said CHRISTOPHER J. CALHOUN has this 12 day of February, 2004 executed application papers for United States Letters Patent thereon;

the said RALPH E. HOLMES has this _____ day of _____, 2004 executed application papers for United States Letters Patent thereon; and

the said G. BRYAN CORNWALL has this 4 day of FEBRUARY, 2004 executed application papers for United States Letters Patent thereon;

WHEREAS, MACROPORE BIOSURGERY, INC., hereinafter called Assignee, having a place of business at 6740 Top Gun Street, San Diego, California 92121, is desirous of acquiring the entire and exclusive right, title and interest in and to the aforesaid invention and in and to any and all Letters Patent therefor granted in the United States of America, and in any and all countries foreign thereto (including the right to apply for Letters Patent in foreign countries in its own name and to claim any priority rights for such foreign applications to which such applications are entitled under international conventions, treaties, or otherwise), in and to the said invention as described in said applications, and in and to all Letters Patent granted therefor, and all divisions, reissues and continuations thereof, and I hereby authorize and request the Commissioner of Patents and Trademarks to issue all Letters Patent on said invention or resulting therefrom to said Assignee, as assignee of my entire right, title and interest, and I covenant that I have full right so to do and agree that I will communicate to said Assignee, or its successors any and all facts known to me regarding said invention whenever requested, and will testify in any legal proceeding, sign all lawful papers, execute all divisional, reissue and continuation applications, and generally do everything possible to aid said Assignee, its successors and assigns, to obtain and enforce proper patent protection for said invention in all countries;

NOW, THEREFORE, TO WHOM IT MAY CONCERN, be it known that, for and in consideration of the sum of ONE DOLLAR (\$1) paid to me in hand paid by Assignee, and other good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, WE, CHRISTOPHER J. CALHOUN, RALPH E. HOLMES and G. BRYAN CORNWALL by these presents do hereby sell, assign and transfer unto Assignee, its successors and assigns, the full and exclusive right, title and interest in and to the said invention, and in and to any Letters Patent which may be granted and issued in the United States and throughout the world therefor;

MA9606P

AND, I HEREBY AUTHORIZE AND REQUEST the Commissioner of Patents and Trademarks to issue said United States Letters Patent to the said MACROPORE BIOSURGERY, INC.,

IN WITNESS WHEREOF, I have executed this instrument at _____

this 12 day of February, 2004.

Witness:
(print name)

RICHARD N. AND

CHRISTOPHER J. CALHOUN

IN WITNESS WHEREOF, I have executed this instrument at _____

this _____ day of _____, 2004.

Witness:

(print name)

RALPH E. HOLMES

IN WITNESS WHEREOF, I have executed this instrument at SAN DIEGO, CA

this 4 day of FEBRUARY, 2004.

Witness:

(print name)

SEAN J. SPANGLER

G. BRYAN CORNWALL

MA9606P

AND, I HEREBY AUTHORIZE AND REQUEST the Commissioner of Patents and Trademarks to issue said United States Letters Patent to the said MACROPORE BIOSURGERY, INC.,

IN WITNESS WHEREOF, I have executed this instrument at _____

this _____ day of _____, 2004.

Witness:
(print name)

CHRISTOPHER J. CALHOUN

IN WITNESS WHEREOF, I have executed this instrument at _____

this 5th day of February, 2004.

Witness:
(print name)

Karl E. Gale

Ralph B. Holmes
RALPH B. HOLMES

IN WITNESS WHEREOF, I have executed this instrument at _____

this _____ day of _____, 2004.

Witness:
(print name)

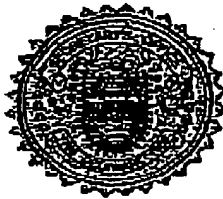
G. BRYAN CORNWALL

Exhibit B
Delaware

The First State

I, HARRIET SMITH WINDSOR, SECRETARY OF STATE OF THE STATE OF DELAWARE, DO HEREBY CERTIFY THE ATTACHED IS A TRUE AND CORRECT COPY OF THE RESTATED CERTIFICATE OF "MACROPORE, INC.", CHANGING ITS NAME FROM "MACROPORE, INC." TO "MACROPORE BIOSURGERY, INC.", FILED IN THIS OFFICE ON THE EIGHTEENTH DAY OF JUNE, A.D. 2002, AT 9 O'CLOCK A.M.

A FILED COPY OF THIS CERTIFICATE HAS BEEN FORWARDED TO THE KENT COUNTY RECORDER OF DEEDS.



Harriet Smith Windsor
Harriet Smith Windsor, Secretary of State

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AUTHENTICATION: 1836189

DATE: 06-18-02